

Appl. N . 09/813,690  
Amendment Dated December 31, 2003  
Reply to Office Action of July 2, 2003

### **REMARKS/ARGUMENTS**

#### **Rejection of Claims Under 35 U.S.C. § 112**

Applicants acknowledge receipt of the Office Action of July 2, 2003 in which claims 6-9, 11 and 19-24 stand rejected under 35 U.S.C. § 112(b) as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In reply, Applicants cancel claims 6-9, 11 and 19-24.

#### **Rejection of Claims Under 35 U.S.C. § 101**

In the Office Action of July 2, 2003, claims 1-26 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory matter, namely, claims 1-26 show a series of steps which are grounded in the abstract idea of, for example, building a database and importing retail prices, and providing list, etc. The broadly recited steps do not recite sufficient computer structure that are within "technical arts". In the Office Action it is acknowledged that claims 1-26 do not satisfy the statutory requirements of 35 U.S.C. § 101. See *In re Toma* 197 USPQ 852 (CCPA 1978).

In reply, Applicants cancel claims 2-24 and amend claims 1 and 25. Applicants submit that amended claims 1 and 25 are in allowable form. Claim 1 has been amended to incorporate the limitations of claims 2 and 5 as well as limiting the method of selling to those via a web site. Claim 1 therefore recites sufficient structure to satisfy the statutory requirements of 35 U.S.C. § 101. Claim 25 does not recite a series of steps, but instead recites an apparatus in the form of a computer coupled to a network. Therefore claim 25 is within the technical arts and is in allowable form. Claim 26 depends on independent claim 25 and is therefore also in allowable form.

#### **Rejection of Claims Under 35 U.S.C. § 102**

In the Office Action of July 2, 2003, claims 1, 2, 5, 7-9, 15-17 and 25-26 are rejected under 35 U.S.C. §102(b) as being anticipated by *Dworkin* US 4,992,940.

In reply, Applicants cancel claims 2-24 and amend claims 1 and 25. Applicants submit that amended claims 1 and 25 are in allowable form. Amended claims 1 and 25 include the

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limitation that the reference price is set as the lowest wholesale price. *Dworkin* does not mention a wholesale price in any form, and therefore does not teach using a wholesale price as the reference price. Therefore amended claims 1 and 25 are not anticipated by *Dworkin* and are in allowable form. Claim 26 depends on independent claim 25 and is therefore also in allowable form.

#### **Rejection of Claims Under 35 U.S.C. § 103**

In the Office Action of July 2, 2003, claims 3, 4, 6, 10-14 and 18-24 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Dworkin* US 4,992,940.

In reply, Applicants cancel claims 3, 4, 6, 10-14 and 18-24.

#### **Conclusion**

Applicants respectfully request reconsideration of this application in light of the foregoing amendments and remarks, withdrawal of the rejections, and allowance of the claims. In the preceding Remarks/Arguments, Applicants may have at times referred to claim limitations in shorthand fashion, or may have focused on a particular claim element. This discussion should not be interpreted to mean that the other limitations can be ignored or dismissed. The claims must be viewed as a whole, and each limitation of the claims must be considered when determining the patentability of the claims. Moreover, it should be understood that there may be other arguments with respect to patentability which have yet to be raised, but which may be raised in the future. This is believed to be a full complete response to each and every ground of rejection and objection raised in the Office Action of July 2, 2003. If Applicants have incompletely addressed any item, an opportunity to supplement this Response is respectfully requested. The format of this Amendment and Response to Office Action is believed to conform with the Revised Amendment Practice as described in "Changes To Implement Electronic Maintenance of Official Patent Application Records," 68 Fed. Reg. 38611 (June 30, 2003).

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All of the pending claims are believed to be free of the prior art, and reconsideration and withdrawal of the rejections are respectfully requested. If a telephone conference would facilitate the resolution of this matter, the Examiner is invited to telephone the undersigned representative. Should any fees have been inadvertently omitted, or if any additional fees are required or have been overpaid, please appropriately charge or credit those fees to Deposit Account Number 03-2769 of Conley Rose, P.C., Houston, Texas, and consider this a petition for any necessary extension of time.

Respectfully submitted,



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